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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

_____

Ex parte ROBERT MARK MAGID

_____

Appeal 2008-3824
Application 10/629,431
Technology Center 2100

_____

Decided:[1] February 19, 2009

_____

Before JOHN C. MARTIN, JEAN R. HOMERE, and
ST. JOHN COURTENAY III, *Administrative Patent Judges*.

Opinion for the Board filed by *Administrative Patent Judge* COURTENAY.

Opinion Concurring-in-part and Dissenting-in-part filed by *Administrative Patent Judge* MARTIN.

COURTENAY, *Administrative Patent Judge*.

_____

<div align="center">DECISION ON APPEAL</div>

<div align="center">STATEMENT OF THE CASE</div>

This is a decision on appeal under 35 U.S.C. § 134(a) from the
Examiner's rejection of claims 1 and 5-30. Claims 2-4 have been cancelled.
We have jurisdiction under 35 U.S.C. § 6(b). We AFFIRM.

<div align="center">INVENTION</div>

The invention on appeal is directed generally to computer software.
More particularly, Appellant's invention is directed to Information
Management System (ISM) software that is used to manage information
stored on mainframe computers, such as the S/390 mainframes
manufactured by International Business Machines, Inc. (Spec. 1).

<div align="center">ILLUSTRATIVE CLAIMS</div>

Claims 1 and 8, which further illustrate the invention, follow:

     1.   A method for intercepting user exit interfaces in
IMS programs, comprising:

        installing a program library at an Information
Management System (IMS) system server as the first
library in an IMS program library concatenation, the
program library including an interception routine;

        dynamically loading an interface routine at the
IMS system server;

        wherein the interception routine communicates
with the interface routine to resolve name ambiguity and
enable simultaneous use of a single exit by plural users,
and the method further comprises:

passing control from an IMS program at the IMS system server to the interface routine;

receiving control at the interception routine from the IMS program; and

establishing the interception routine as a user exit routine.

8.   The method of Claim 7, further comprising:

comparing a "candidate user-exit" load module to a predetermined interception routine "eye-catcher"; and

treating a non-matching "candidate user-exit" load module as a user exit routine.

PRIOR ART

The Examiner relies upon the following references as evidence in support of the rejections:

Fortin	US 5,528,753	Jun. 18, 1996
Baer	US 6,035,303	Mar. 7, 2000
Chan	US 6,460,178 B1	Oct. 1, 2002

THE REJECTIONS

Claims 21-30 stand rejected under 35 U.S.C. § 101 as being directed to non statutory subject matter.

Claims 1, 11-14, and 21-24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Fortin and Baer.

Claims 5-10, 15-20, and 25-30 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Fortin, Baer, and Chan.

GROUPING OF CLAIMS

Appellant argues independent claim 1 separately, and contends that "[t]he arguments above [directed to claim 1] apply *mutatis mutandis* to independent claims 11 and 21." (App. Br. 7). Appellants do not present separate arguments for dependent claims 12-14 and 22-24 that also stand rejected as being obvious over the combination of Fortin and Baer. We will, therefore, treat claims 1, 11-14, and 21-24 as standing or falling with representative claim 1. *See* 37 C.F.R. § 41.37(c)(1)(vii).

Appellant argues claim 8 separately (App. Br. 7-8). Appellants do not present separate arguments for claims 9 and 10 that depend upon claim 8. We will, therefore, treat claims 8-10 as standing or falling with representative claim 8.

Appellant presents no arguments directed to the separate patentability of claims 5-7, 15-20, and 25-30 that stand rejected as being unpatentable over the combination of Fortin, Baer, and Chan.

APPELLANT'S CONTENTIONS

Regarding the Examiner's rejection of claims 21-30 under 35 U.S.C. § 101, Appellant affirmatively states that "[c]laim 21 must be interpreted in accordance with the principles of 35 U.S.C. §112, sixth paragraph, invoking means-plus-function language, MPEP § 2181 to limit the claim to what is shown and described in the specification and structural equivalents thereto."

(App. Br. 8). Based on the support found in the Specification, Appellant contends that claims 21-30 are directed statutory subject matter (App. Br. 8-9).

Regarding the Examiner's rejection of representative claim 1 that stands rejected as being unpatentable over the combination of Fortin and Baer, Appellant contends that "[n]owhere does Fortin address the topic of enabling a single exit (*appearing in all independent claims*) to be used by multiple users." (App. Br. 5).[2] Appellant also contends that the portions of Fortin relied on by the Examiner do not even hint at anything resembling resolution of name ambiguity, as claimed in each independent claim (App. Br. 5-6).

Regarding the Examiner's rejection of representative claim 8 that stands rejected as being unpatentable over the combination of Fortin, Baer, and Chan, Appellant contends that "[t]here is simply no comparison of anything at all in the relied-upon portions of Fortin, much less the particularly recited comparison of, e.g., claim 8." (App. Br. 8).

Regarding the obviousness rejections of both claims 1 and 8, Appellant contends that the Examiner has improperly relied upon hindsight reconstruction (App. Br 7-8). Appellant also presents a "teaching away" argument regarding the Fortin teaching of single entry and single exit routines that are selected from plural routines (App. Br. 6).

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[2] Appellant presents a new argument in the Reply Brief that Fortin does not teach plural calls directed *simultaneously* to a single exit (Reply Br. 2-3). We consider this new argument to be untimely. *See Optivus Tech., Inc. v. Ion Beam Applications S.A.*, 469 F.3d 978, 989 (Fed. Cir. 2006) (an issue not raised in an opening Brief is waived).

<div align="center">EXAMINER'S RESPONSE</div>

Regarding Appellant's arguments directed to the 101 rejection of claims 21-30, the Examiner concludes that the claimed "logic means" (claim 21) are limited to logic, i.e., program code or software per se, which is not the same as physical means, such as hardware (Ans. 13-14).

Regarding Appellant's arguments directed to the obviousness rejection of representative claim 1, the Examiner finds that Fortin's common exit code (718, Fig. 7, col. 6, l. 62) teaches a single exit that is used by plural target routines (Ans. 10).

Regarding the Appellant's arguments directed to the obviousness rejection of representative claim 8, the Examiner responds as follows:

> However, FIG. 6A of Fortin discloses computing and retrieving the Address for [User Supplied] Exit Instrumentation Routine. Furthermore, FIG.7 of Fortin discloses the Instrumentation Library storing the Common Exit Code, User Supplied Entry Instrumentation Routines, and User Supplied Exit Instrumentation Routines. It is respectfully submitted that without comparing the User Supplied Instrumentation Routine (i.e., "candidate user-exit") to a predetermined interception routine 'eye catcher' (e.g., either Common Exit Code or the User Supplied Entry Instrumentation Routines in the Instrumentation Library of FIG.7), it would be impossible for the demux-entry of FIG.6A to select (i.e., treating the "candidate user-exit" as a user exit routine) and compute the right address for the Exit Instrumentation Routine.

(Ans. 13).

<div align="center">ISSUES</div>

Based upon our review of the administrative record, we have determined that the following issues are dispositive in this appeal:

1. Has Appellant shown error in the Examiner's legal conclusion that claims 21-30 are directed to non statutory subject matter under 35 U.S.C. § 101?

2. Has Appellant shown that the primary Fortin reference teaches away from Appellant's claimed invention?

3. Has Appellant shown that the Examiner has erred by relying upon impermissible hindsight?

4. Has Appellant shown error in the Examiner's finding that the combination of Fortin and Baer teaches and/or suggests the use of a single exit by plural users? (*See* independent claims 1, 11, and 21).

5. Has Appellant shown error in the Examiner's finding that the combination of Fortin and Baer teaches and/or suggests resolving name ambiguity? (*See* independent claims 1, 11, and 21)

6. Has Appellant shown error in the Examiner's finding that the combination of Fortin and Baer teaches and/or suggests a comparison, as recited in claim 8?

PRINCIPLES OF LAW

"If a claim covers material not found in any of the four statutory categories, that claim falls outside the plainly expressed scope of § 101 even if the subject matter is otherwise new and useful." *In re Nuijten,* 500 F.3d 1346, 1354 (Fed. Cir. 2007).

"What matters is the objective reach of the claim. If the claim extends to what is obvious, it is invalid under *§ 103*." *KSR Int'l Co. v. Teleflex, Inc.,*

127 S. Ct. 1727, 1742 (2007). To be nonobvious, an improvement must be "more than the predictable use of prior art elements according to their established functions." *Id.* at 1740.

FINDINGS OF FACT

In our analysis *infra*, we rely on the following findings of fact (FF) that are supported by a preponderance of the evidence:

THE FORTIN REFERENCE

1. Fortin teaches that an instrumentation call is directed to the appropriate common and user specific exit routines (col. 5, ll. 50-51; *see also* Fig. 7, common exit code 718).

2. Fortin teaches that the "demux-entry code saves the registers and calls 718 the common Exit code and calls 720 the user supplied Exit instrumentation routine with the return value from the target routine as a parameter." (Col. 6, ll. 61-64).

3. Fortin teaches that target routines are selected by the user (col. 5, ll. 11-12).

THE BAER REFERENCE

4. Baer teaches that advanced information management system structures are required to store and manage digitized data (col. 1, ll. 17-19).

5. Baer teaches an ordered collection of elements, each identified by a key (col. 2, ll. 34-35).

> 6. Baer teaches a distributed object system including a library
> server 110 (Fig. 1).

<div align="center">ANALYSIS</div>

At the outset, we consider Appellant's arguments only to the extent that such arguments are directed to claimed subject matter.

<div align="center">ISSUE 1</div>

We decide the question whether Appellant has shown error in the Examiner's legal conclusion that claims 21-30 are directed to non statutory subject matter under 35 U.S.C. § 101. For convenience, we reproduce independent claim 21, as follows:

> 21. A computer program device for intercepting user exit interfaces in IMS programs, comprising:
> logic means for communicating between an interception routine and an interface routine to resolve name ambiguity and enable simultaneous use of a single exit by plural users.

(Claim 21).

We note that Appellant has expressly invoked 112, sixth paragraph, not only in the principal Brief (page 8), but also in the last line of the Specification: "No claim element herein is to be construed under the provisions of 35 U.S.C. section 112, sixth paragraph, unless the element is expressly recited using the phrase 'means for.'" (Spec. 8).

Therefore, we look to Appellant's Specification for guidance on the intended scope of the claimed "logic means" (claim 21). In particular, we look to the Specification to identify the corresponding structure for the

<div align="center">9</div>

function of "communicating between an interception routine and an interface routine to resolve name ambiguity and enable simultaneous use of a single exit by plural users." (Claim 21).[3]

The pertinent portion of the Specification (pointed to by Appellant) begins on page 4 and continues to page 5, as follows:

> It is to be understood that in the system 10 described above, *the logic of the present invention can be contained on a data storage device with a computer readable medium, such as a computer diskette.* Or, the instructions may be stored on a magnetic tape, hard disk drive, electronic read-only memory (ROM), optical storage device, or other appropriate data storage device or transmitting device thereby making a computer program product, i.e., an article of manufacture according to the invention. In an illustrative embodiment of the invention, the computer-executable instructions may be written using mainframe assembler language. Moreover, the IMS user program 24 may be written using assembler, PL/I, FORTRAN, COBOL, Pascal, REXX, or Java.

> *The flow charts herein illustrate the structure of the logic of the present invention as embodied in computer program software.* Those skilled in the art will appreciate that the flow charts illustrate the structures of computer program code elements *including logic circuits on an integrated circuit*, that function according to this invention. Manifestly, the invention is practiced in its essential embodiment by a machine component that

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[3] In *Aristocrat Techs. Austl. Pty Ltd. v Inter. Game Tech.*, 521 F.3d 1328 (Fed. Cir. 2008), the court set forth that for a claim to a programmed computer, a particular algorithm may be the corresponding structure under § 112, sixth paragraph.

> renders the program elements in a form that instructs a
> digital processing apparatus (that is, a computer) to
> perform a sequence of function steps corresponding to
> those shown.

(Spec. 4-5, emphasis added).

Thus, consistent with the Specification, we find that the 112, sixth paragraph scope of the claimed "logic means" broadly encompasses at least a first embodiment that consists of software per se: "[t]he flow charts herein illustrate the structure of the logic of the present invention as embodied in computer program software." (Spec. 5, ll. 7-8). We also find that the 112, sixth paragraph scope of the claimed "logic means" broadly encompasses at least a second embodiment where "computer program code elements [include] logic circuits on an integrated circuit." (i.e., firmware) (Spec. 5, ll. 9-10).

Thus, the intended scope of Appellant's claim 21 broadly encompasses statutory subject matter (i.e., logic circuits on an integrated circuit) as well as non statutory subject matter (i.e., software per se). Our reviewing court has clearly stated that "[t]he four categories [of § 101] together describe the exclusive reach of patentable subject matter. If a claim covers material not found in any of the four statutory categories, that claim falls outside the plainly expressed scope of § 101 even if the subject matter is otherwise new and useful." *In re Nuijten,* 500 F.3d at 1354. Because the scope of the claimed "logic means" clearly covers material not found in any of the four statutory categories (i.e., software per se), we conclude that independent claim 21 is non statutory under 35 U.S.C. § 101. Because dependent claims 22-30 do not remedy the deficiencies of claim 21, we also conclude that claims 22-30 are non statutory under 35 U.S.C. § 101.

ISSUE 2

We decide the question of whether Appellant has shown that the primary Fortin reference teaches away from Appellant's claimed invention.

As discussed regarding ISSUE 4 *infra*, we find Appellant has mischaracterized (App. Br. 6, ¶1) the thrust of the Examiner's rejection by shifting the focus to Fortin's user-supplied exit routine 720, instead of traversing the Examiner's specific finding that Fortin's common exit code (718, Fig. 7, col. 6, l. 62) teaches a single exit that is used by plural target routines (i.e., users) (Ans. 10, 12, ¶¶1-3). Moreover, "[t]he prior art's mere disclosure of more than one alternative does not constitute a teaching away from any of these alternatives because such disclosure does not criticize, discredit, or otherwise discourage the solution claimed . . . ." *In re Fulton*, 391 F.3d 1195, 1201 (Fed. Cir. 2004). This reasoning is applicable here. Accordingly, we find Appellant's "teaching away" arguments unavailing.

ISSUE 3

We decide the question whether Appellant has shown the Examiner has erred by relying upon impermissible hindsight.

With respect to the issue of hindsight, in *KSR* the U.S. Supreme Court reaffirmed that "[a] factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of arguments reliant upon *ex post* reasoning." *KSR*, 127 S. Ct. at 1742. *See also Graham v. John Deere Co.*, 383 U.S. at 36. Nevertheless, in *KSR* the Supreme Court also qualified the issue of hindsight by stating that "[r]igid preventative rules that deny factfinders recourse to common sense, however, are neither necessary under our case law nor consistent with it." *KSR*, 127 S. Ct. at 1742-43.

In *KSR*, the Supreme Court further stated:

> When a work is available in one field of endeavor,
> design incentives and other market forces can
> prompt variations of it, either in the same field or a
> different one. If a person of ordinary skill can
> implement a predictable variation, § 103 likely
> bars its patentability. For the same reason, if a
> technique has been used to improve one device,
> and a person of ordinary skill in the art would
> recognize that it would improve similar devices in
> the same way, using the technique is obvious
> unless its actual application is beyond his or her
> skill.

KSR, 127 S. Ct. at 1740.

This reasoning is applicable here. The Examiner looks to the
secondary Baer reference for its teaching of storing routines in an IMS
library (Ans. 4). While Appellant contends that the Examiner's proffered
motivation to combine has been made without regard to what the references
fairly teach or suggest (App. Br. 7), Appellant fails to specifically traverse
the Examiner's finding that an artisan would have been motivated to
combine Fortin and Baer to make access of library objects (i.e., common exit
routines) available to *multiple users* as well as allowing the users to store
and retrieve said objects (Ans. 5; *see also* FF 5-6). Therefore, we find
Appellant has not met his/her burden of showing that the Examiner has erred
by relying on impermissible hindsight in formulating the rejection (*see* App.
Br. 7, 8).

ISSUE 4

We decide the question whether Appellant has shown error in the
Examiner's finding that the combination of Fortin and Baer teaches and/or
suggests the use of a single exit by plural users (*see* independent claims 1,
11, and 21).

While Appellant contends that Fortin does not address the topic of
enabling a single exit to be used by multiple users (App. Br. 5), we find
Appellant has mischaracterized (App. Br. 6, ¶1) the thrust of the Examiner's
rejection by shifting the focus to Fortin's user-supplied exit routine 720,
instead of traversing the Examiner's specific finding that Fortin's common
exit code (718, Fig. 7, col. 6, l. 62) teaches and/or suggests a single exit that
is used by plural target routines (i.e., where each target routine is associated
with a user) (Ans. 10, 12, ¶¶1-3). We note that Fortin teaches that the
demux-entry code first calls the common Exit code 718 (relied on by the
Examiner), that is followed by a call to the user supplied Exit
instrumentation routine 720 (FF 1-2). We find the Examiner's association of
plural users with plural target routines is supported by Fortin's teaching that
the target routines are selected by the user (FF 3). We also find that Baer's
teaching of an object library suggests that multiple users (i.e., clients) access
the object library (FF 6). We note that the Examiner's rejection is based on
the *combination* of the references. Thus, we find the weight of the evidence
supports the Examiner's position as set forth in the Answer. Accordingly, we
find Appellant has not met his/her burden of showing that the Examiner
erred.

ISSUE 5

We decide the question whether Appellant has shown error in the Examiner's finding that the combination of Fortin and Baer teaches and/or suggests resolving name ambiguity. (*see* independent claims 1, 11, and 21).

After reviewing the record before us, we find Appellant has failed to traverse the Examiner's specific finding that "[i]t should be noted that col. 2:33-57 of Baer expressly discloses identifying each Java Object with a unique key (which comprises text string(s) and object attributes (e.g., name of the Java Object)), obviously, to avoid name/identity ambiguity (Emphasis added)." (Ans. 11; *see also* FF 5). Therefore, we find Appellant has not met his/her burden of showing that the Examiner erred.

ISSUE 6

We decide the question whether Appellant has shown error in the Examiner's finding that the combination of Fortin and Baer teaches and/or suggests a comparison, as recited in claim 8.

Appellant contends that "[t]here is simply no comparison of anything at all in the relied-upon portions of Fortin, much less the particularly recited comparison of, e.g., claim 8." (App. Br. 8). However, our review of the Briefs indicates that Appellant has failed to address the Examiner's specific findings regarding the comparison the Examiner indicates is necessarily (i.e., inherently) present in the Fortin reference, as follows:

> It is respectfully submitted that without comparing the User Supplied Instrumentation Routine (i.e., "candidate user-exit") to a predetermined interception routine 'eye catcher' (e.g., either Common Exit Code or the User Supplied Entry Instrumentation Routines in the Instrumentation Library of FIG.7), it would be

> impossible for the demux-entry of FIG.6A to select (i.e.,
> treating the "candidate user-exit" as a user exit routine) and
> compute the right address for the Exit Instrumentation Routine.

(Ans. 13).

Based upon the above, we find the Examiner has provided a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent "comparison" necessarily flows from the teachings of Fortin. "[A]fter the PTO establishes a prima facie case of anticipation based on inherency, the burden shifts to appellant to 'prove that the subject matter shown to be in the prior art does not possess the characteristic relied on.'" *In re King*, 801 F.2d 1324, 1327 (Fed. Cir. 1986) (quoting *In re Swinehart*, 439 F.2d 210, 212-13 (CCPA 1971)). *See also* MPEP §§ 2112 (IV.), (V.). While the present case pertains to § 103, and not § 102, we note that the question of obviousness is "based on underlying factual determinations including . . . what th[e] prior art teaches explicitly and inherently . . . ." *In re Zurko*, 258 F.3d 1379, 1383 (Fed. Cir. 2001) (citing *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966); *In re Dembiczak*, 175 F.3d 994, 998 (Fed. Cir. 1999); *In re Napier*, 55 F.3d 610, 613 (Fed. Cir. 1995)).

Here, Appellant has not met the burden of proving with evidence that the subject matter shown to be in the prior art does not possess the characteristic relied on by the Examiner. Therefore, we find Appellant has not met his/her burden of showing that the Examiner erred.

<center>Dependent claims 5-7, 15-20, and 25-30</center>

Appellant did not separately argue these claims that stand rejected as being unpatentable over the combination of Fortin, Baer, and Chan. Thus, Appellant has not shown the Examiner erred in rejecting claims 5-7, 15-20, and 25-30. *See* 37 C.F.R. § 41.37(c)(1)(vii) ("Notwithstanding any other provision of this paragraph, the failure of appellant to separately argue claims which appellant has grouped together shall constitute a waiver of any argument that the Board must consider the patentability of any grouped claim separately.").

<center>CONCLUSION</center>

Based on the findings of facts and analysis above, Appellant has not established that the Examiner erred in rejecting claims 21-30 under 35 U.S.C. § 101.

Based on the findings of facts and analysis above, Appellant has not established that the Examiner erred in rejecting claims 1 and 5-30 under 35 U.S.C. § 103(a) for obviousness.

DECISION

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

<u>AFFIRMED</u>

MARTIN, *Administrative Patent Judge*, concurring-in-part and dissenting-in-part.

I write separately because I respectfully disagree with the Majority on two points.

The first point is the Majority's finding that Appellant has not traversed "the Examiner's specific finding that Fortin's common exit code . . . teaches a single exit that is used by plural target routines (i.e., users)." (Majority op. at 12, Issue 2.)

In the last (nonfinal) Office action (at 4), the Examiner equated "users" with "client routines" in finding that "a common exit code clearly anticipates a single instance of a given exit interface that is used by multiple target routines/users." I note that the Examiner's language, "exit interface," differs from the claim language argued by Appellant, which reads "use of a single *exit* by plural users" (emphasis added). Thus, the Examiner's above finding implied that the Examiner was construing the term "exit" to be broad enough to read an exit interface, i.e., Fortin's Common Exit Code. However, as pointed out by the Majority, in the Answer the Examiner specifically found that "the Common Exit Code clearly teaches a Single *Exit* that is used by plural Target Routines" (emphasis added). (Ans. 10.)

In the Brief, Appellant did not expressly challenge the Examiner's above equation of "target routines" with "users" or the Examiner's finding that Fortin's Common Exit Code is an "exit interface." Instead, Appellant argued that Fortin fails to disclose "multiple target routines using a single exit," as required by the claims:

> Elements 720 and 722 are lines drawn between the common exit code in the library and a user-supplied exit routine, strongly implying just the opposite of what is claimed. The relied-upon

> part of col. 5 of Fortin discloses that an "entry [i.e.,
> demultiplexer entry] is provided *for each target routine*", lines
> 48 and 49, and that a single entry and single exit routine are
> selected from plural routines, lines 53-55. Both of these
> teachings are strongly suggestive of an exit/entry being selected
> for a specific target routine, the opposite of multiple target
> routines using a single exit.

(App. Br. 6.) In the Reply Brief, Appellant further argues that

"'[i]nstrumenting' a large number of routines is not the same thing as

providing a single exit to plural user, ..."[4] Reply Br. 1-2.

The Majority found that in making the above-quoted argument in the

Brief,

> Appellant has mischaracterized (App. Br. 6, ¶1) the thrust of the
> Examiner's rejection by shifting the focus to Fortin's user-
> supplied exit routine 720, instead of traversing the Examiner's
> specific finding that Fortin's common exit code (718, Fig. 7,
> col. 6, l. 62) teaches a single exit that is used by plural target
> routines (i.e., users) (Ans. 10, 12, ¶¶1-3).

(Majority op. at 12, Issue 2.[5]) I do not entirely agree that Appellants'

argument fails to traverse "the Examiner's specific finding that Fortin's

common exit code . . . teaches a single exit that is used by plural target

routines." My understanding of Appellant's argument is that the Common

Exit Code, the user supplied exit routines, and the demultiplexer entries

collectively will fail to result in multiple target routines using a single "exit,"

which argument strikes me as implicitly traversing the Examiner's

conclusion that the claim term "exit" is broad enough to read on the

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[4] The remainder of this sentence reads, "much less providing it
simultaneously to plural users as required by, e.g., Claim 1." I agree with
the Majority's finding (supra, p. 5 n.2) that Appellant's reliance on the
claim term "simultaneously" is belated and entitled to no consideration.
[5] A similar finding appears at Majority op. at 14, Issue 4.

Common Exit Code. Specifically, Appellant's argument suggests that
Appellant believes the claim term "exit" should be limited to an exit point.
However, Appellant has not provided a satisfactory explanation of why the
claim term "exit," when given its broadest reasonable interpretation
consistent with the rest of the claim language and the remainder of
Appellant's application, should be so narrowly construed. For this reason
and for the other reasons cited by the Majority, I concur in the Majority's
affirmance of the § 103(a) rejections with the exception of the rejection of
claims 8-10, addressed below.

My second point of disagreement with the Majority is that I would
reverse rather than affirm the § 103(a) rejection of claim 8 and its dependent
claims 9 and 10. Claim 8 depends on claim 1 through claims 5-7 and calls
for:

> comparing a "candidate user-exit" load module to a
> predetermined interception routine "eye-catcher"; and
> treating a *non-matching* "candidate user-exit" load
> module as a user exit routine.

(Claims App., Br. 11) (emphasis added). As noted by the Majority, the
Examiner found that such a comparison is inherently present in Fortin:

> It is respectfully submitted that without comparing the User
> Supplied Instrumentation Routine (i.e., "candidate user-exit") to
> a predetermined interception routine 'eye catcher' (e.g., either
> Common Exit Code or the User Supplied Entry Instrumentation
> Routines in the Instrumentation Library of FIG.7), it would be
> impossible for the demux-entry of FIG.6A to <u>select</u> (i.e.,
> treating the "candidate user-exit" as a user exit routine) and
> <u>compute</u> the right address for the Exit Instrumentation Routine.

(Ans. 13.) Appellant responded by arguing:

> Whatever the merits or lack thereof of the various "id ests" and
> "exempli gratia" used throughout the argument above as well as

> the Answer as a whole, what is noteworthy is that nowhere does
> Fortin teach, nor do the conferees allege, that a *non-matching*
> candidate user-exit toad module is treated as a user exit routine.
> No mention appears in this portion of the Answer about what
> happens if no match is found in Fortin, much less that a non-
> matching entity is treated as anything, much less still that it is
> treated as a user exit routine.

(Reply Br. 3) (emphasis added). I find this argument persuasive and would
accordingly reverse the § 103(a) rejection of claim 8 and its dependent
claims 9 and 10.

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